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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/373,018	08/11/99	NASH	H 10845/014002

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HM22/0829

EXAMINER

HSU, G

ART UNIT	PAPER NUMBER
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1627

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DATE MAILED:

08/29/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/373,018**

Applicant(s)

**Nash et al.**

Examiner

**Grace Hsu, Ph.D.**

Group Art Unit

**1627**



☒ Responsive to communication(s) filed on Jul 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 16-22 and 51-72 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 16-22 and 51-72 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

*Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Examiner at Jyothsna Venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.*

1. Claims 16-22 and 51-57 are pending in the instant application.
2. The Second Supplemental Preliminary Amendment received on July 24, 2000 was entered as Paper No. 9.

### *Election of Species*

3. This application contains claims directed to patentably distinct species of the claimed invention.
4. Applicants are required to elect in claims 16-22 and 51-57:

- [1] a single core compound structure; and
- [2] a single compound species,

**for each of the following elements/components of the claimed invention defined in the aforementioned claims:**

- [a] a member of a mass encoded library, XY<sub>n</sub>, i.e.:
  - [1] an X scaffold and the constituent components of the corresponding reactive groups, peripheral moieties, covalent bond elements, etc.;
  - [2] a Y component and what the constituents of corresponding reactive groups, peripheral moieties, covalent bond elements, etc.;
  - [3] distinctions between bound vs. unbound members

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- [b] biomolecule -i.e. protein, amino acid sequence, nucleic acid, polypeptide, i.e.:
  - [3] first biomolecule -i.e. protein, amino acid residue or sequence, nucleic acid, polypeptide;
  - [4] second biomolecule -i.e. protein, amino acid residue or sequence, nucleic acid, polypeptide;
  - [5] respective biomolecule-ligand complexes -i.e. protein, amino acid sequence, nucleic acid, polypeptide;
- [c] ligand -i.e. protein, amino acid sequence, nucleic acid, polypeptide;
- [d] associated modes of bond contact -i.e. types of bonds, such as covalent bonds and what chemical elements form those bonds, e.g. an amide linkage, peptide linkage, etc. and how each of the groups are linked together;
- [e] scaffold precursors and the constituent components of the corresponding reactive groups, peripheral moieties, covalent bond elements, etc.;
- [f] peripheral moieties, peripheral moiety precursor subsets and the constituent components of the corresponding reactive groups, peripheral moieties, covalent bond elements, etc.;

**wherein for each of the above identified groups an identification should be defined for each core formula and species, i.e.,  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$ , etc. and each respective sub-group defined therein.**

Each of the species encompassed by the claimed invention represent patentably distinct subject matter. In the instant case, those species each involve different structures and modes of action. Therefore, those species involve different patentability and enablement issues.

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Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16, 64 and 68 are generic.

**For search purposes, applicants also should provide a chemical structure of a single compound species for each of the above-identified species, wherein specific chemical formula substituents of attached to the core formula are defined either by picture or by expressing the species in terms of the variables of the formula.**

5. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

6. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D. whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 6:00 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jyothsna Venkat, Ph.D., may be reached at (703) 308-2439. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this

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application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

Grace C. Hsu, Ph.D., J. D.

August 27, 2000

  
DR. JYOTHSNA VENKAT PH.D  
SUPERVISORY PATENT EXAMINER  
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